

**UNITED STATES DEPARTMENT OF COMMERCE**  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
87-944,505	09/14/92	COLLINS	M 25.835-06

EXAMINER	
CHAMBERS, S	
ART UNIT	PAPER NUMBER
1007	3

**DATE MAILED:**

AMOCO CORPORATION  
PATENTS AND LICENSING DEPT., M.C. 1907A  
200 EAST RANDOLPH DRIVE  
P. O. BOX 87703  
CHICAGO, IL 60680-0703

**This is a communication from the examiner in charge of your application.**

**COMMISSIONER OF PATENTS AND TRADEMARKS**

11/05/92

11/05/92  
Final Resp due (2) 1/5/93  
(3) 2/5/93

- ☐ This application has been examined ☒ Responsive to communication filed on Sept 14/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I** **THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ \_\_\_\_\_

**Part II** Page 2 of 2 **SUMMARY OF ACTION**

1. ☒ Claims 1-24 are pending in the application.  
Of the above, claims 24 <sup>is</sup> are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-23 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable;  
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 180 Art Unit 1807.

Examiner notes that in E.I. du Pont de Nemours & Co. v. Cetus Corp., 19 USPQ2d 1174 at 1185 (N.D.Ca. 1991), the court indicated that grant proposals to the NIH and NSF were prior art due to the requirements of the Freedom of Information Act (see 45 C.F.R. §5.1 et seq. and §6.12 et seq.). This may be of some interest to applicants in satisfying 37 C.F.R. 1.56.

Applicants are requested to look over the specification and correct any minor errors.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-23, drawn to a method of nucleic acid amplification, classified in Class 435, subclass 6 and 91.

II. Claim 24, drawn to an apparatus and measuring device, classified in Class 435, subclass 291 & 293.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case the process as claimed can be practiced by hand as pointed out in the disclosure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, as well as the fact that the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.



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#3

AMOCO CORPORATION  
55 SHUMAN BLVD., STE. 600  
NAPERVILLE, IL 60563-8487

Serial No: 08/238,080

Date of Deposit: 05/03/94

Applicant: MARK L. COLLINS

Dear Sirs:

Your patent application was received in the Patent and Trademark Office Mailroom on 5-3-94, and given Serial Number 08/238080. Your check in the amount of \$ 872.00 is unacceptable and the following action has been taken:

- ☒ Your check for \$ 872.00 was unsigned and is enclosed herewith.
- ☐ Your check was not drawn on U. S. Bank and is enclosed herewith.
- ☐ Your check was not payable to the Commissioner of Patent and Trademarks and is enclosed herewith.
- ☒ The fee in the amount of \$ 872.00 has been charged to your Deposit Account as authorized in the transmittal letter.

RECEIVED JUN 03 1994

BOBBIE DAVENPORT  
Administrative Examination Unit  
Application Branch (703) 308-1202

MAILED  
JUN 03 1994  
APPLICATION BRANCH